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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,904	05/31/2000	Avner Shafrir	52817.000111	2748

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,904

Applicant(s)

SHAFRIR ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/29/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. This Office Action is in response to the Amendment entered on April 27, 2005.
2. The patent application claims priority from domestic US Application 60/137,513 filed June 2, 1999.
3. The Information Disclosure Statement submitted on April 29, 2005 is considered and entered into the File.
4. The pending claims 1-33 are examined herein as follows.

Response to the submitted Declaration Under 37 C.F.R § 1.131

5. The Declaration under 37 CFR 1.131 filed on April 27, 2005 has been considered but is ineffective to overcome the ICQ, i.e., ICQ Email Signature, published May 2, 1999 reference.

To begin with, the Declaration fails to disclose all the signatures of the named inventors of the pending application.

Furthermore, the Declaration submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the ICQ Email Signature reference. The Declaration must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms without submitting evidence (in the form of exhibits) along with a general assertion to reduce the invention to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must

give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Thus, the applicant fails to provide the facts that are sufficient to show reduction to practice to the invention prior to the effective date of the reference.

Claim Rejections - 35 U.S. C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-33 are rejected under 35 U.S.C 103(a) as being unpatentable over Mirabilis LTD. Quick Tour. February 12, 1998 in view of ICO Inc. ICO Email Signature, May 2 1999.

ICQ, as described and illustrated in Mirabilis LTD, Quick Tour, is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence (on-line status indicator) to those whose list (contact list) you are on and notifies you if

your contacts are on-line (status indicator) as well. This status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Moreover, as described below, it is clear that the current claims are not distinguishable over the cited art.

Per claim 1:

As per "status determining means," ICQ, as describes and illustrates in Quick Tour, does provide plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet (Quick Tour, page 5).

As per "status indicator presenting means," as mentioned above, ICQ, as describes and illustrates in Quick Tour, provides the status indicator (such as online or offline) and also provides user indicators (such as names or IDs) associated with the status indicators. By clicking or selecting the indicator one can establish communication with other users with a selected communication mode (Quick Tour, pages 5-6).

As per "user indicator presentation means," ICQ, as described and illustrated in Quick Tour, does teach a user indicator presentation means, such as name, ICQ's unique ID number, etc that are associated with the user (Quick Tour, pages 1-3). As mentioned above any one of these indicators allows you to connect or link to others by clicking on the indicator (Quick Tour, pages 1-3).

Although ICQ describes user indicator presentation means, but ICQ does not expressly describe "enabling presentation of one ore more user indicators within the two or more types of electronic documents, wherein the electronic document types are

capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user.”

ICQ Inc, ICQ Email Signature describes these shortcomings. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Furthermore, Quick Tour in view of ICO Email Signature further discloses that the status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (see Quick Tour, pages 5-6

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

Per claims 6, 13, 18, and 26-29:

The remaining independent claims, 6, 13, 18, 26-29 are rejected for the same reason given to claim 1.

Per claims 2, 4, 14, 16, and 19:

ICQ provides a status indicator such as a flower symbol which changes color (color-coded) based on the user's status (Quick Tour, page 4).

Per claims 3, 8, 15, and 20:

ICQ further discloses status indicators displayed in a menu (Quick Tour, page 5).

Per claims 5, and 17:

As illustrated in page 5, the user indicator is selected by selecting the status indicator icon for the selected user (Quick Tour, pages 4-5).

Per claim 7:

As illustrated in page 5, symbol icon is used to indicate the status indicator of a user (Quick Tour, pages 4-5).

Per claims 9, and 21:

The status indicators includes color-coding, that is, the symbol (flower icon) changes to green to announce your presence to those whose list you are on. (See Quick Tour, pages 4-5).

Per claims 10, 12, 22-25:

ICQ, as mentioned above, does provide several communication preference to a user, such preference include, e-mail, chat, send message files and URLs, play games, draw on whiteboards, communicate through voice while surfing the net (see page 6). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, page 6).

Per claim 11:

ICQ user is able to establish or initiate one or more communications such as using ICQ's voice, or data sharing applications with one or more network users (Quick Tour, page 6).

Per claims 30 and 31:

ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Per claim 32:

In addition to the limitations recited in system claim 1, the system of claim 32, further recites a user directory (which is similar to Quick Tour in view of Email Signature, contact information) that includes user information and the user information further includes user indicators as described and illustrated in ICQ (Quick Tour in view of Email Signature, see Quick Tour, pages 5-6). Claim 32 further recites document generated by two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web document, etc, see Quick Tour). The document further includes at least two user depictions associated with at least two network users (which is similar to Quick Tour in view of Email Signature user indicator icon, see Quick Tour). Claim 32 further recites an identification-determining module (which is similar to Quick Tour in view of Email Signature name, ICQ number or contact information, see Quick Tour).

Per claim 33:

In addition to the limitations recited in system claim 1, the system of claim 33, further recites document generated by two or more applications (which is similar to Quick Tour in view of Email Signature e-mail document, chat document, web document, etc) and each of the documents includes a plurality of fields (which is similar to Quick Tour in view of Email Signature name, address, etc fields, see Quick Tour).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

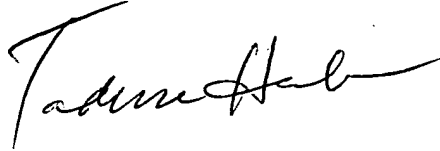
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

Art Unit: 2173

10. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patent Examiner
Tadesse Hailu
6/23/05

A handwritten signature in black ink, appearing to read "Tadesse Hailu", written in a cursive style.